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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,975	12/11/2000	Thomas Moran	476-1962	4647
23644	7590	07/11/2005	EXAMINER	
BARNES & THORNBURG P.O. BOX 2786 CHICAGO, IL 60690-2786			PATEL, ASHOKKUMAR B	
			ART UNIT	PAPER NUMBER
			2154	

DATE MAILED: 07/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/734,975

Applicant(s)

MORAN, THOMAS

Examiner

Ashok B. Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-19 are subject to examination.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/9/2005 has been entered.

Response to Arguments

3. Applicant's arguments with respect to claim 1, 11, 15, 16, 17, 18 and 19 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 10-12, and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Pinter (US 5, 894, 506).

Referring to claim 1,

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Pinter teaches a messaging system arranged to allow a user to send a pre-specified message (col. 2, line 1-6) to a destination party mail box (col. 1, line 38-42), said messaging system comprising a communications network (Fig. 1) comprising:-

- a) a messaging server arranged to store a pre-specified message associated with said user; (col. 2, line 1-6)
- b) an input to the communications network arranged to receive a user input from said user; (col. 1, line 50-66) and
- c) a destination party mail box; wherein when a specified user input is received from said user at the input, the pre-specified message is sent to the destination party mail box from the messaging server. (col. 3, line 64 – col. 4, line 3).

Referring to claim 2,

Pinter teaches a messaging system as claimed in claim 1 wherein said input comprises a terminal connected to the communications network and comprising a user interface. (Fig. 1, element 10).

Referring to claim 3,

Pinter teaches a messaging system as claimed in claim 2 wherein the terminal is connected to the messaging server via a communications network node being a private branch exchange. (col. 3, line 30-43).

Referring to claim 10,

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Pinter teaches a messaging system as claimed in claim 1 wherein the pre-specified message is stored in a mail box on the messaging server, said mail box being associated with the user. (col. 5, line 45-49).

Referring to claim 11,

Pinter teaches a method of sending a pre-specified message associated with a user, from said user to a destination party mail box in a communications network (col. 2, line 1-6, col. 1, line 38-42, Fig. 1), said method comprising the steps of:-

- (i) storing said pre-specified message at a messaging server in the communications network; (col. 2, line 1-6)
- (ii) receiving an input from said user, said input indicating that the pre-specified message is to be sent to the destination party mail box; (col. 1, line 50-66) and
- (iii) sending the pre-specified message from the messaging server to the destination party mail box. (col. 3, line 64- col. 4, line 3).

Referring to claim 12,

Pinter teaches a method as claimed in claim 11 wherein the input is received via a terminal. (Fig. 1, element 10).

Referring to claims 15,

Pinter teaches a messaging server for sending a pre-specified message associated with a user, from said user to a destination party mail box in a communications network (Fig. 1, col. 2, line 1-6, col. 1, line 38-42), said messaging server (Fig. 1, element 12) comprising:

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- (i) a store containing the pre-specified message; (Fig. 1, element 12).
- (ii) an input arranged to receive information from said user, said information indicating that the pre-specified message is to be sent to the destination party mail box (Fig. 1, element 10);
- (iii) a processor arranged to send the pre-specified message to the destination party mail box. (Fig. 1, element 12, col. 2, line 1-6, col. 1, line 38-42, col. 3, line 64- col. 4, line 3).

Referring to claim 16,

Pinter teaches a communications network comprising a destination party mail box and a messaging server for sending a pre-specified message associated with a user, from said user to the destination party mail box, said messaging server (Fig. 1) comprising:

- (i) a store containing the pre-specified message associated with said user; (Fig. 1, element 12)
- (ii) an input arranged to receive information from said user, said information indicating that the pre-specified message is to be sent to the destination party mail box (Fig. 1, element 10); and
- (iii) a processor arranged to send the pre-specified message to the destination party mail box. (Fig. 1, element 12, col. 2, line 1-6, col. 1, line 38-42, col. 3, line 64- col. 4, line 3).

Referring to claim 17,

Claim 17 is a claim to a computer program that carries out the method steps of claim 15. Therefore, claim 17 is rejected for the reasons set forth for the claim 15.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4-9, 13, 14, 18 and 19 are rejected under 35 U.S.C. 103(a) as being Unpatentable over Pinter (US 5, 894, 506) in view of Baxter Jr. (hereinafter Baxter) (US 6, 385, 305).

Referring to claim 4,

Keeping in mind the teachings of Pinter as stated above, although Pinter teaches the messaging server comprises a processor (Fig.1, element 12) sending a pre-specified message, Pinter explicitly fails to teach to append information received from a user of the pre-specified message.

Baxter teaches " additional step to the method describe above might include encoding a sponsor message into the electronic message wherein the encoding a sponsor message comprises the step of appending the digital audio file with an audio sponsor message. Alternatively, the method might include encoding a text-based sponsor message into the body of the electronic message or encoding a sponsor message comprises the step of encoding one or more graphic elements into the body of the electronic message." (col.4, lines 14-23, Fig.6, elements 110, 120)).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention was made to enhance Pinter's NOC's capabilities with Baxter's

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teachings of appending the information to the message and delivering it to the destination. Thus, this systems provide a benefit of transmitting digital audio file attachments to an email address without requiring the recipient to first set up an account with a service as taught by Baxter.

Referring to claims 5 and 6,

Keeping in mind the teachings of Pinter as stated above, although Pinter teaches the messaging server comprises a processor (Fig.1, element 12) sending a pre-specified message, Pinter explicitly fails to teach to append information received from a user to the pre-specified messages to create a combined message such that in use the messaging server is later able to separate the appended information from the combined message and wherein the processor is arranged to create the combined message such that in use, when the combined message is displayed to a user the appended information is displayed as part of the pre-specified message.

Baxter teaches " additional step to the method describe above might include encoding a sponsor message into the electronic message wherein the encoding a sponsor message comprises the step of appending the digital audio file with an audio sponsor message. Alternatively, the method might include encoding a text-based sponsor message into the body of the electronic message or encoding a sponsor message comprises the step of encoding one or more graphic elements into the body of the electronic message." (col.4, lines 14-23, Fig.6, elements 110, 120). Baxter also teaches "the voice mail server 30 then records the caller's audio voice message 90 onto a storage medium. The voice message is compressed and encoded into a digital audio

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file 40 and then attached to the email address previously identified 110. The email and digital audio file attachment is then opened and listened to by the recipient 260. (col. 10, lines 18-23). (to append information received from a user to one of the pre-specified messages to create a combined message such that in use the messaging server is later able to separate the appended information from the combined message and wherein the processor is arranged to create the combined message such that in use, when the combined message is displayed to a user the appended information is displayed as part of the pre-specified message).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention was made to enhance Pinter's NOC's capabilities with Baxter's teachings of appending the information to the message and delivering it to the destination as shown in Fig.6 by Baxter. Thus, this systems provide a benefit of transmitting digital audio file attachments to an email address without requiring the recipient to first set up an account with a service as taught by Baxter.

Referring to claims 7 and 8,

Keeping in mind the teachings of Pinter as stated above, Pinter fails to specifically teach wherein the messaging server is a multimedia messaging server, and wherein the destination party mail box is located on a second messaging server.

Baxter teaches " additional step to the method describe above might include encoding a sponsor message into the electronic message wherein the encoding a sponsor message comprises the step of appending the digital audio file with an audio sponsor message. Alternatively, the method might include encoding a text-based

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sponsor message into the body of the electronic message or encoding a sponsor message comprises the step of encoding one or more graphic elements into the body of the electronic message.” (col.4, lines 14-23, Fig.6, elements 110, 120). (wherein the messaging server is a multimedia messaging server, and wherein the destination party mail box is located on a second messaging server.)

Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention was made to enhance Pinter’s NOC’s capabilities with Baxter’s teachings of appending the information to the message and delivering it to the destination as shown in Fig.6 by Baxter. Thus, this systems provide a benefit of transmitting digital audio file attachments to an email address without requiring the recipient to first set up an account with a service as taught by Baxter.

Referring to claim 9,

Keeping in mind the teachings of the reference Pinter as stated above, although Pinter teaches the messaging server comprises a processor (Fig.1, element 12) sending a pre-specified message, Pinter explicitly fails to teach to the communications network node is arranged to route the additional information to the messaging server together with one or more control signals that are arranged to indicate that the additional information is to be appended to a pre-specified message.

Baxter teaches a method of transmitting one or more audio file attachments in an electronic message from a telephone including the steps of dialing into a predetermined telephone number, sending one or more DTMF signals on the touch-tone telephone corresponding to a preselected email address wherein the one or more DTMF signals is

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associated with a predetermined alphanumeric character, assembling a string of alphanumeric characters by repeating the DTMF signal entry until the preselected email address has been completed, recording an audio voice message over the touch-tone telephone, converting the audio voice message into a digital audio file, attaching the digital audio file to an electronic message directed to the preselected email address, and transmitting the electronic message to the preselected email address. (Abstract, col. 4, line 53 through col. 5, line 9, Note: PDA can dial-in).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention was made to enhance Pinter's NOC's capabilities with Baxter's teachings of appending the information to the message and delivering it to the destination as shown in Fig.6 by Baxter. Thus, this systems provide a benefit of transmitting digital audio file attachments to an email address without requiring the recipient to first set up an account with a service as taught by Baxter.

Referring to claims 13 and 14,

Keeping in mind the teachings of Pinter as stated above, although Pinter teaches the messaging server comprises a processor (Fig.1, element 12) sending a pre-specified message, Pinter fails to teach receiving to be appended to the pre-specified message, and wherein that communications network node is arranged to send a control signal to the messaging server, indicating that the received information is to be appended to the pre-specified message. The reference Baxter teaches a method of transmitting one or more audio file attachments in an electronic message from a telephone including the steps of dialing into a predetermined telephone number, sending one or more DTMF

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signals on the touch-tone telephone corresponding to a preselected email address wherein the one or more DTMF signals is associated with a predetermined alphanumeric character, assembling a string of alphanumeric characters by repeating the DTMF signal entry until the preselected email address has been completed, recording an audio voice message over the touch-tone telephone, converting the audio voice message into a digital audio file, attaching the digital audio file to an electronic message directed to the preselected email address, and transmitting the electronic message to the preselected email address. (Abstract, col. 4, line 53 through col. 5, line 9, Note: PDA can dial-in).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention was made to enhance Pinter's NOC's capabilities with Baxter's teachings of appending the information to the message and delivering it to the destination as shown in Fig.6 by Baxter. Thus, this systems provide a benefit of transmitting digital audio file attachments to an email address without requiring the recipient to first set up an account with a service as taught by Baxter.

Referring to claim 18,

Keeping in mind the teachings of the reference Pinter as stated above, although the Pinter teaches the messaging server comprises a processor (Fig.1, element 12) sending a pre-specified message associated with the user, Pinter explicitly fails to teach a communications signal arranged to be routed between a terminal and a messaging server, said communications signal comprising information associated with a user and a

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control signal which indicates that the information is to be appended to a pre-specified message at the messaging server.

Baxter teaches a method of transmitting one or more audio file attachments in an electronic message from a telephone including the steps of dialing into a predetermined telephone number, sending one or more DTMF signals on the touch-tone telephone corresponding to a preselected email address wherein the one or more DTMF signals is associated with a predetermined alphanumeric character, assembling a string of alphanumeric characters by repeating the DTMF signal entry until the preselected email address has been completed, recording an audio voice message over the touch-tone telephone, converting the audio voice message into a digital audio file, attaching the digital audio file to an electronic message directed to the preselected email address, and transmitting the electronic message to the preselected email address. (Abstract, col. 4, line 53 through col. 5, line 9, Note: PDA can dial- in).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention was made to enhance Pinter's NOC's capabilities with Baxter's teachings of appending the information to the message and delivering it to the destination as shown in Fig.6 by Baxter. Thus, this systems provide a benefit of transmitting digital audio file attachments to an email address without requiring the recipient to first set up an account with a service as taught by Baxter.

Referring to claim 19,

Keeping in mind the teachings of the reference Pinter as stated above, although Pinter teaches the messaging server comprises a processor and a communications

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network node arranged to be connected between a terminal and a messaging server, said communications network node comprising a processor arranged to set up a call between the terminal and the messaging server and to route information associated with a user from the terminal to the messaging server using this call, (Fig.1, elements 10, 12, and 14), sending a pre-specified message associated with the user, Pinter fails to teach wherein the processor is further arranged to send a control signal with the routed information, said control signal indicating that the routed information is to be appended to a pre-specified message at the message server.

Baxter teaches a method of transmitting one or more audio file attachments in an electronic message from a telephone including the steps of dialing into a predetermined telephone number, sending one or more DTMF signals on the touch-tone telephone corresponding to a preselected email address wherein the one or more DTMF signals is associated with a predetermined alphanumeric character, assembling a string of alphanumeric characters by repeating the DTMF signal entry until the preselected email address has been completed, recording an audio voice message over the touch-tone telephone, converting the audio voice message into a digital audio file, attaching the digital audio file to an electronic message directed to the preselected email address, and transmitting the electronic message to the preselected email address. (Abstract, col. 4, line 53 through col. 5, line 9, Note: PDA can dial- in).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention was made to enhance Pinter's NOC's capabilities with Baxter's teachings of appending the information to the message and delivering it to the

destination as shown in Fig.6 by Baxter. Thus, this systems provide a benefit of transmitting digital audio file attachments to an email address without requiring the recipient to first set up an account with a service as taught by Baxter.

Conclusion

Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

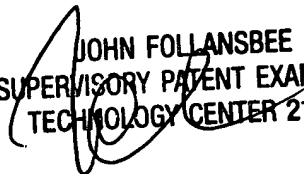
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashok B. Patel whose telephone number is (571) 272-3972. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Abp


JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100